

### **REMARKS**

The present Amendment and Response is responsive to the Non-final Office Action mailed on May 12, 2008 (hereinafter, the "Office Action").

Claims 1-69 and 80-91 were cancelled previously, and claims 70-79 are pending in the application.

Applicants respectfully remind the Examiner that a personal interview was held at the U.S. Patent and Trademark Office on Monday, May 7, 2007 (over 17 months ago) with our representatives Stephan Filipek and Michael Downs regarding this application. Our representatives were grateful for the opportunity to discuss the present application with the Examiner in view of the non-final Office Action mailed on February 23, 2007, and were hopeful that agreement could be reached regarding allowable subject matter. In fact, our representatives believed that an agreement was reached because the Examiner indicated that replacing the word "corresponding" with --linked-- would serve to clarify the scope of claims **70, 73 and 76-79**, and to patentably distinguish them from the cited Taskett patent (U.S. Patent No. 5,684,291). In reliance on the statements made by the Examiner during that meeting, Applicants filed an Amendment and Response on May 11, 2007 that replaced the word "corresponding" with --linked-- in the appropriate claims. However, instead of a Notice of Allowance, a Restriction Requirement was mailed on January 4, 2008, and Applicants responded by cancelling the Group II claims, again believing that such action would possibly provide for the allowance of the Group I claims. Thus, Applicants were disappointed to receive the present Office Action, which contains further rejections based on another reference that is no better than the Taskett patent. In view of the remarks that follow, Applicants are again hopeful that the Examiner will advance prosecution rather than merely prolonging it.

In view of the following remarks, Applicants respectfully request allowance of all of the pending claims.

**A. Amendments to the Specification**

The specification has been amended herein on page 1 to update the priority information. In particular, Applicants have provided patent numbers for those cases that have issued and indicated abandonment for those cases that have lapsed. No new matter has been added, and thus the entry of these changes is respectfully requested.

In addition, Applicants kindly request the Examiner to facilitate the correction of the priority information associated with the present application within the U.S. Patent and Trademark Office. In particular, we noticed that the information currently listed on private PAIR does not reflect all of the priority data for this application. It appears that a clerk at the U.S. Patent and Trademark Office failed to notice that the Preliminary Amendment filed on July 10, 2000 for this application, and the transmittal letter, included a claim to priority of U.S. Patent Application No. 08/997,680, which is a continuation in part of U.S. Patent Application No. 08/762,128, and which is a continuation in part of U.S. Patent Application No. 08/858,738. Applicants of course wish to have the correct data reflected in the file for this application, and thus we ask the Examiner to ensure that the correct priority information is provided to the proper person for data entry in the present application.

**B. The Objections to the Claims**

Claims 70, 73, and 76-79 have been objected to for allegedly being substantial duplicates of claims 73, 74, 75, 77 and 79. Applicants traverse.

We understand that, inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, as recognized by the MPEP, court decisions have confirmed applicant's right to restate (for example, by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough (See MPEP, Section 706.03(k), first paragraph). In the present application, it is clear that claims 70, 71, 72, 76 and 78 differ in scope from

claims 73, 74, 75, 77 and 79. For example, independent claim 73 specifies *distributing the gift certificate to a recipient different from the owner of the financial account*, whereas independent claim 70 specifies *distributing said gift certificate to an owner of the financial account*. Claims 71 and 72 depend from claim 70 and therefore incorporate the same limitations as claim 70, whereas independent system claim 76 and independent computer readable storage medium claim 78 both contain the same limitation as claim 70; similarly, claims 74 and 75 depend from claim 73 and therefore incorporate the same limitations, whereas independent system claim 77 and independent computer readable storage medium claim 79 both contain the same limitation as claim 73.

Accordingly, since it is clear that a difference in scope exists between these two sets of claims, Applicants respectfully request withdrawal of this objection to claims 70-79.

#### **C. The Double Patenting Rejection**

Claims 70 and 73 have been provisionally rejected on the ground of non-statutory double patenting over claim 1 of copending U.S. Application no. 11/423,161 (hereinafter, “the ‘161 application”).

Claim 1 of the ‘161 application was cancelled in an Amendment and Response that Applicants filed on April 12, 2007, which Response also added claims 70-109. Thus, this provisional double patenting rejection is moot.

In view of the above remarks, Applicants respectfully request withdrawal of this double patenting rejection.

#### **D. The Section 102(a) Rejections**

Claims 70-79 have been rejected under 35 U.S.C. §103(a) for allegedly being anticipated by Spector, U.S. Patent No. 5,870,718 (hereinafter, “Spector”).

Spector is directed to a computer printer Internet terminal adapted to produce, under user control, a composite greeting and gift certificate card. The card is redeemable by the named recipient at a retail store that is linked to the Internet which had authorized

the issuance of the certificate. The terminal includes greeting card and gift certificate software downloaded by the user that makes it possible to compose and print out the composite card (see Spector, Abstract and col. 1, lines 7-13). Spector specifically teaches and claims the terminal for production of the composite card (see, for example, claim 1 at col. 4, line 38 to col. 5, line 5). Spector describes a gift certificate card section “CS” that includes the name of the retail store, a registration number of the certificate, the product or products to which the card applies, and the money amount of the gift (col. 4, lines 6-11 and Fig. 2). Spector teaches that the user must first identify a store that carries the desired product, chose the a product or service he or she wishes to give as a gift, be informed of the Internet data to be printed on the gift certificate section, and then pay for the gift certificate by credit card over the Internet (col. 4, lines 14-21). The payment procedure may involve a security control center that issues a special security number to the user. The user can bill the gift certificate to his or her credit card, or telephone charge account, or bank account (col. 4, lines 21-27).

There is absolutely ***no basis*** for the Examiner’s assertion that Spector discloses *generating a certificate identifier linked to an account identifier that is associated with a financial account, said certificate identifier being different from said account identifier* as required by each of independent claims 70, 73 and 76-79. The portion of Spector cited by the Examiner and discussed above (col. 4, lines 14-24 and the gift card section “CS” shown in Fig. 2), merely disclose a “security number” or a “certificate number” that is printed on the composite card 20. There is ***no*** teaching or suggestion that such a security number or certificate number is linked to anything, much less linked to an account identifier that is associated with a financial account, as required by claims 70, 73 and 76-79. Furthermore, Spector teaches to provide a certificate number as a “security number” that only appears to be associated with the amount paid for the gift certificate (see col. 4, lines 21-24). There is ***no*** teaching or even a suggestion that the certificate number is associated with any account whatsoever.

Accordingly, in view of the above remarks, Applicants assert that claims 70, 73 and 76-79 are ***not*** anticipated. In addition, since each of claims 71 and 71 directly

depend on claim 70, and each of claims 74 and 75 directly depends on claim 76, then these dependent claims are also not anticipated for at least the same reasons.

In view of the above remarks, Applicants respectfully request favorable reconsideration and the withdrawal of all of the Section 102(a) rejections.

**E. Conclusion**

In view of the above remarks, the Applicants respectfully submit that all of the claims are in condition for allowance, early notice of which would be appreciated.

If the Examiner has any questions concerning the pending claims or any of the comments contained herein, the Examiner is requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at [sfilipek@walkerdigital.com](mailto:sfilipek@walkerdigital.com).

**F. Petition for Extension of Time and Authorization to Charge Appropriate Fees**

Applicants hereby petition for a two month extension of time to respond to the Office Action, and authorize the Commissioner to charge our Deposit Account No. 50-0271; Order No. 96-140-C1 for the surcharge fee. No other fees are believed to be due for this Amendment and Response, but please charge any fees that may be required to continue prosecution to Deposit Account No. 50-0271. In addition, please credit any overpayment to the same Deposit Account.

Respectfully submitted,

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Date

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